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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,174	10/23/2003	Benjamin N. Eldridge	P47C2-US	8347

50905	7590	02/07/2008
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EXAMINER	
ABRAMS, NEIL	

ART UNIT	PAPER NUMBER
2839	

NOTIFICATION DATE	DELIVERY MODE
02/07/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/692,174

Applicant(s)

ELDRIDGE ET AL.

Examiner

Neil Abrams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-17-2007.
- 2a) ☒ This action is FINAL.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26, 33, 35, 36, 41, 42, 48, 73-85, 87, 89-92, 94, 97-99, 103-110 is/are pending in the application.
- 4a) Of the above claim(s) 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26, 33, 36, 41, 42, 48, 73-85, 87, 89-92, 94, 97-99, 103-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

☐ Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

DETAILED ACTION

The rejections set forth in the last office action are again applied and are set forth below as in that office action

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 105, 106, 108, 109 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-15 of U.S. Patent No. 6, 520,778 the parent case in view of Fjelstad, Littlebury and Shida. Parent case claims include features of claims 105, etc but lack use of palladium cobalt for tip. Fjelstad, Littlebury discussed previously disclose use of palladium with Fjelstad teaching use of palladium alloy. Obvious to use such material for parent case claims 8 tip and also obvious to select any particular known alloy including palladium cobalt as suggest by Shida. This material provides good conductivity and wear resistance.

3. Claims 26, 33, 36, 41, 42, 48, 73-99, 103-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faraci in view of Fjelstad, Yanof, Littlebury and Shida.
4. The patents are applied as in last office action but with Shida now applied to suggest palladium cobalt alloy (column 3, lines 55-60). For claims 105-110 probe overlap and truncated pyramid features treated as obvious variations since applicant has not asserted these as part of the inventive concept and all arguments have been to the palladium cobalt limitations. In addition for claims 107, 110, truncated pyramid shape seen to be equivalent to Faraci tips 320 of truncated conical shape since the change is not asserted to produce new results.
5. Claims 26, 33, 36, 41, 42, 48, 73-99, 103-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaman 982 in view of Fjelstad, Shida, Yanof and Littlebury.
6. The patents are applied in last office action but with Shida now used as noted above. Claims 103-110 treated as obvious variations as discussed above. In addition for claims 107, 110 pyramid tip would be obvious variation of Beaman, figure 10, tip 71, since the change is not asserted to produce any stated result.
7. Claims 107, 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaman, etc as applied to claims 26, 42 above, and further in view of Farnworth.
8. Beaman, figure 10, tip 71 does not meet claim language. Farnworth, figure 9 at 64a uses truncated pyramid tip. As alternative basis of rejection obvious to use such type of tip in place of tip 71 of Beaman. Such tip is read as including both a base and a

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pyramid part. As alternative, obvious to use tip of Littlebury type at 14, 16, 17 but with part 17 formed as pyramid as in Farnsworth at 64. Both changes are to provide concentrate forces.

Applicant's arguments filed with the last response have been fully considered but they are not persuasive.

These claims set forth a specific material for a contact tip. The articulated reasoning is that selection of a material is typically deemed a matter of obvious design in absence of any new or unobvious result produced by such selection. The mere naming of a material for a contact does not automatically render a claim patentable even if the combination not be exactly taught by the prior art. In this case a material is set forth with no evidence or even assertion of such unobvious result. and therefore it is deemed proper to apply secondary references for suggestion of use of such material. The rejection does not call for substitution of a tip of one reference for another but only that it would have been obvious to form the contact tips of the primary references of the materials suggested in the secondary references. Comment in the last office action are also included as follows

The references teach use of palladium or its alloys for probe tips (see 414 of Fjelstad, 35 of Yanof, 17 of Littlebury). Selection of a known type palladium alloy would have been obvious in absence of a teaching of new result from such change. It is well known that choice of materials is within the level of those skilled in the art. In this case applicant in specification, page 43, lines 29, 30 calls for tip
and page 41, lines 1-10
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formed of "palladium and its alloys, particularly palladium cobalt". The brief mention of the material is not seen to overcome prior art teachings. Shida is not essential to the rejection but is added for teaching of use palladium cobalt alloy for electrical contact parts, hence to reinforce obviousness of such use as discussed above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Neil Abrams at telephone number 571-272-2089


NEIL ABRAMS
PRIMARY EXAMINER